

REMARKS

Claims 1-31 and 33-38 are pending. Claim 32 was previously cancelled. No Claims are amended herein and no new matter has been added.

CLAIM REJECTIONS - 35 U.S.C. § 102(e)

Anticipation Requirements

According to MPEP 2131, “to anticipate a claim, the reference must teach every element of the claim.” Further, as cited in MPEP 2131, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Additionally, according to MPEP 2131, “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Claims 1-4, 8-11, 13-16, 24, 26-27, 29, 31, 33, and 35-37

The instant Office Action states that Claims 1-4, 8-11, 13-16, 24, 26-27, 29, 31, 33, and 35-37 are rejected under 35 U.S.C. § 102(e) as being anticipated by Jacobson et al., U.S. Patent 6,466,796 B1 (hereafter “Jacobson”). Applicants have reviewed Jacobson and respectfully submit that the embodiments recited in Claims 1-4, 8-11, 13-16, 24, 26-27, 29, 31, 33, and 35-37 are not anticipated by Jacobson for at least the following rationale.

Independent Claim 1, recites:

A method of determining a location of a mobile unit, said method comprising:
receiving a telephone number of a wireline telephone through a data network, said wireline telephone being located in a vicinity of said mobile unit, and said telephone number being wirelessly transmitted to said data network by said mobile unit;
retrieving an address associated with said telephone number; and
retrieving said location of said mobile unit based on said address.

Independent Claims 18 and 31 recite similar features and were rejected with the same rationale used for rejecting Claim 1. Claims 2-17 depend from Claim 1 and recite further features of Claim 1. Claims 19-30 depend from Claim 18 and recite further features of Claim 18. Claims 31 and 33-38 depend from Claim 31 and recite further features of Claim 31.

Applicants respectfully submit that Jacobson fails to disclose each and every element of Claim 1 and therefore fails to make a *prima facie* case for an anticipation rejection of Claim 1. For example, Applicants submit that Jacobson does not teach “receiving a telephone number of a wireline telephone through a data network, said wireline telephone being located in a vicinity of said mobile unit...” (emphasis added) as is recited in Claim 1 and similarly in Claims 18 and 31. The Rejection, page 2, contends that this is taught in Figure 1 of Jacobson (with telephone number 114 of a wireline 111/112) and at col. 4 lines 1-38 of Jacobson. Applicants disagree. Instead, Applicants submit that, as indicated in col. 4, lines 25-27, of Jacobson,

Path 113 is representative a loop connecting a telephone station 114 to switching system 110. For purposes of the present discussion, telephone

station 114 is associated with a telephone number that provides location based telephone services to callers.

Although, telephone station 114 provides location based services, nothing in Jacobson indicates or teaches that telephone station 114 is located in the vicinity of a particular mobile unit. Rather, with reference to col. 5, lines 37-43 of Jacobson, and step 308 of Jacobson's Figure 3, it is clear that:

In step 308, the location information retrieved is used to determine the telephone number of the location based service provider that provides service to the location is determined. The telephone call is then routed to the location based service provider that provides service to the location of the caller in step 309.

In other words, if a mobile user/wireless telephone is calling for location based services the system of Jacobson figures this out (e.g., steps 306 and 307 of Jacobson's Figure 3 and col. 5, lines 24-35), then figures out the location of the mobile user/wireless telephone (col. 3, lines 58-62), and routes the user's/wireless telephone's phone call to a phone number that services the user's/wireless telephone's location (e.g., steps 308 and 309 of Jacobson's Figure 3 and col. 5, lines 35-43). To extrapolate from Jacobson, if, for instance, the wireless telephone is calling from a mobile phone in Kansas, Jacobson could very well route the wireless telephone phone call to an appropriate service provider located at a telephone station in Texas, Germany, or even the South Pole for that manner -- so long as the service provider provided location based services for the location of the mobile user/telephone that called for the services. This is because nothing in Jacobson indicates that the telephone station 114 of a location based service provider is anywhere in the vicinity of the location of the mobile user/calling wireless telephone; only that the telephone station 114 is one that provides

services to the user's/wireless telephone's location. Moreover, while Jacobson may route a call from a mobile user/wireless telephone to the telephone number of the nearest service provider based upon location data in a priority list (see Figure 7 and col. 7 of Jacobson), again, there is no teaching or suggestion that the location of this telephone number is "in the vicinity" of the calling mobile user/wireless telephone only (at most) that it is closer to the mobile user's/wireless telephone's location than some other service provider is. Thus, extrapolating from Jacobson, a mobile user/wireless telephone calling from Kansas might be routed to a service provider located in Texas rather than a service center in Germany or at the South Pole.

Furthermore, Applicants submit that Jacobson does not teach or suggest, "retrieving an address associated with said telephone number," as is recited in Claim 1 and similarly in Claim 18 and Claim 31. The Rejection, page 2 contends that this is taught in col. 4, lines 1-23; col. 6, lines 55-67; and col. 6, lines 1-20 of Jacobson. Applicants disagree. While col. 6, lines 1-20 and 57-67 indicate that certain types of location information regarding a wireless telephone set 101 are retrieved, nothing in these cited sections teaches "retrieving an address associated with said telephone number," where the phone number is that of a wireline phone. Moreover, while col. 4, lines 16-20 indicate that "memory 117 stores service provider database 118...a database containing location data and area of coverage for the various service providers," this does not teach or suggest the detail or specificity of, "retrieving an address associated with said telephone number," where the phone number is that of a wireline phone, as has been recited in Claim 1 and similarly in Claims 18 and 31.

Additionally, Applicants submit that Jacobson does not teach or suggest, “retrieving said location of said mobile unit based on said address,” as is recited in Claim 1 and similarly in Claim 31. The Rejection, page 2 contends that this is taught in col. 5, lines 55-67; and col. 6, lines 1-7 of Jacobson. Applicants disagree. Instead, Applicants submit that Jacobson indicates on col. 3, lines 58-67, that “[l]ocation system 108 is a system that can determine the location of wireless telephone set 101 by monitoring the RF signals 102 received by antenna 103 from wireless telephone set 101.” While this may allude to some form of triangulation or RF signal strength based determination of the location of a wireless telephone set, Applicants submit it is very different than, and does not teach or suggest, “retrieving said location of said mobile unit based on said address,” as is recited in Claim 1 and similarly in Claim 31.

Thus, Applicants submit that the 35 U.S.C. §102(e) rejection to Jacobson is improper and Claims 1, 18, and 31 are not anticipated by Jacobson. As such, Applicants submit that Claims 1-4, 8-11, and 13-16 that depend from Claim 1; Claims 19-22, 24, 26-27, and 29 that depend from Claim 18, and Claims 33 and 35-37 that depend from Claim 31, are also allowable over the 35 U.S.C. §102(e) rejection to Jacobson, at least by virtue of their dependence from allowable base claims.

CLAIM REJECTIONS - 35 U.S.C. § 103(a)

Claims 6 and 7

Claims 6 and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jacobson in view of U.S. Patent 6,680,935 B1 to Kung et al. (hereafter “Kung”).

Applicants have reviewed the cited art and respectfully submit that the embodiments as recited in Claims 6 and 7 are patentable over Jacobson in view of Kung for at least the following reasons.

Claims 6 and 7 depend from Claim 1 and recite further features of Claim 1. As described above, Applicants believe Claim 1 to be allowable over Jacobson. Per Applicants’ understanding neither Kung nor the combination of Jacobson in view of Kung cures the deficiencies noted above with respect to Jacobson. Additionally, the present Rejection fails to explain why the above identified differences between Applicants’ claimed inventions and Jacobson in view of Kung would have been obvious to one of ordinary skill in the art.

As such, Applicants respectfully submit that independent Claim 1 overcomes the rejection under 35 U.S.C. §103(a), and that this claim is thus in a condition for allowance. Applicants respectfully submit the combination of Jacobson in view of Kung also does not teach or suggest the claimed embodiments as recited in Claims 6 and 7 that depend from independent Claim 1, and that Claims 6 and 7 overcome the rejection under 35 U.S.C. §103(a) to Jacobson and Kung and are in a condition for allowance by virtue of their dependence from an allowable base claim.

Claims 5 and 23

Claims 5 and 23 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jacobson in view of U.S. Patent Publication 2002/0045456 A1 to Obradovich. Applicants have reviewed the cited art and respectfully submit that the embodiments as recited in Claims 5 and 23 are patentable over Jacobson in view of Obradovich for at least the following reasons.

Claim 5 depends from Claim 1 and recites further features of Claim 1. Claim 23 depends from Claim 18 and recites further features of Claim 18. As described above, Applicants believe Claims 1 and 18 to be allowable over Jacobson. Per Applicants' understanding neither Obradovich nor the combination of Jacobson in view of Obradovich cures the deficiencies noted above with respect to Jacobson. Additionally, the present Rejection fails to explain why the above identified differences between Applicants' claimed inventions and Jacobson in view of Obradovich would have been obvious to one of ordinary skill in the art.

As such, Applicants respectfully submit that independent Claims 1 and 18 overcome the rejections under 35 U.S.C. §103(a), and that these claims are thus in a condition for allowance. Applicants respectfully submit the combination of Jacobson in view of Obradovich also does not teach or suggest the claimed embodiments as recited in Claim 5 that depends from independent Claim 1 or Claim 23 that depends from independent Claim 18, and that Claims 5 and 23 overcome the rejection under 35 U.S.C. §103(a) to Jacobson and Obradovich and are in a condition for allowance by virtue of their dependence from allowable base claims.

Claim 12

Claim 12 is rejected under 35 U.S.C. §103(a) as being unpatentable over Jacobson in view of U.S. Patent Publication 2003/047518 to Albal et al. (hereafter “Albal”). Applicants have reviewed the cited art and respectfully submit that the embodiment as recited in Claim 12 is patentable over Jacobson in view of Albal for at least the following reasons.

Claim 12 depends from Claim 1 and recites further features of Claim 1. As described above, Applicants believe Claim 1 to be allowable over Jacobson. Per Applicants’ understanding neither Albal nor the combination of Jacobson in view of Albal cures the deficiencies noted above with respect to Jacobson. Additionally, the present Rejection fails to explain why the above identified differences between Applicants’ claimed inventions and Jacobson in view of Albal would have been obvious to one of ordinary skill in the art.

As such, Applicants respectfully submit that independent Claim 1 overcomes the rejection under 35 U.S.C. §103(a), and that this claim is thus in a condition for allowance. Applicants respectfully submit the combination of Jacobson in view of Albal also does not teach or suggest the claimed embodiment as recited in Claim 12 that depends from independent Claim 1, and that Claim 12 overcomes the rejection under 35 U.S.C. §103(a) to Jacobson and Albal and is in a condition for allowance by virtue of its dependence from an allowable base claim.

Claims 17, 25, 28, 30, 34, and 38

Claims 17, 25, 28, 30, 34, and 38 are rejected under 35 U.S.C. §103(a) as being unpatentable over Jacobson in view of U.S. Patent Publication 2003/0104822 to Bentley. Applicants have reviewed the cited art and respectfully submit that the embodiments as recited in Claims 17, 25, 28, 30, 34, and 38 are patentable over Jacobson in view of Bentley for at least the following reasons.

Claim 17 depends from Claim 1 and recites further features of Claim 1. Claims 24, 28, and 30 depend from Claim 18 and recites further features of Claim 18. Claims 34 and 38 depend from Claim 31 and recite further features of Claim 31. As described above, Applicants believe Claims 1, 18, and 31 to be allowable over Jacobson. Per Applicants' understanding neither Bentley nor the combination of Jacobson in view of Bentley cures the deficiencies noted above with respect to Jacobson. Additionally, the present Rejection fails to explain why the above identified differences between Applicants' claimed inventions and Jacobson in view of Bentley would have been obvious to one of ordinary skill in the art.

As such, Applicants respectfully submit that independent Claims 1, 18, and 31 overcome the rejections under 35 U.S.C. §103(a), and that these claims are thus in a condition for allowance. Applicants respectfully submit the combination of Jacobson in view of Bentley also does not teach or suggest the claimed embodiments as recited in Claim 17 that depends from independent Claim 1, Claims 25, 28, and 30 that depend

from independent Claim 18, or Claims 34 and 38 that depend from Claim 31 and that Claims 17, 25, 28, 30, 34, and 38 overcome the rejection under 35 U.S.C. §103(a) to Jacobson and Bentley and are in a condition for allowance by virtue of their dependence from allowable base claims.

CONCLUSION

In light of the above-listed remarks, reconsideration of the rejected claims is requested. Based on the amendments and arguments presented above, it is respectfully submitted that Claims 1-31 and 33-38 overcome the rejections of record. Therefore, allowance of Claims 1-31 and 33-38 is respectfully solicited.

Should the Examiner have a question regarding the instant amendment and response, the Applicants invite the Examiner to contact the Applicants' undersigned representative at the below listed telephone number.

Respectfully submitted,
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